

ESTTA Tracking number: **ESTTA234356**

Filing date: **09/03/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	3M ESPE AG
Granted to Date of previous extension	09/03/2008
Address	ESPE PLATZ SEEFELD, D-82229 GERMANY
Attorney information	Scott W. Johnston Merchant & Gould P.C. P.O. Box 2910 Minneapolis, MN 55402-0910 UNITED STATES sjohnston@merchantgould.com, slindemeier@merchantgould.com, dockmpls@merchantgould.com Phone:(612) 332-5300

Applicant Information

Application No	79034429	Publication date	05/06/2008
Opposition Filing Date	09/03/2008	Opposition Period Ends	09/03/2008
International Registration No.	0912990	International Registration Date	10/20/2006
Applicant	Fluorotechnics Pty Limited R257 Building E8C Macquarie University; NORTH RYDE NSW 2109 AUSTRALIA		

Goods/Services Affected by Opposition

<p>Class 001.</p> <p>All goods and services in the class are opposed, namely: Biological and chemical products, preparations and reagents other than for medical or veterinary use, being biological and chemical test kits comprised of alkaline solutions and epicocconone for electrophoresis, protease and proteolysis monitoring, proteomics analysis, protein staining, fluorescent protein staining, protein quantification, blot staining, peptide analysis and live cell imaging, and buffers containing products, preparations and reagents for biotechnology and scientific research; fluorescent compounds and kits comprised of alkaline solutions and epicocconone for electrophoresis, protease and proteolysis monitoring, proteomics analysis, protein staining, fluorescent protein staining, protein quantification, blot staining, peptide analysis, and live cell imaging, and buffers consisting thereof for use in biotechnology and scientific research</p>
<p>Class 005.</p> <p>All goods and services in the class are opposed, namely: Biological products for electrophoresis, protease and proteolysis monitoring, proteomics analysis, protein staining, fluorescent protein staining, protein quantification, blot staining, peptide analysis, live cell imaging and buffer</p>

preparations and reagents for medical or veterinary use; chemical products, preparations and reagents for medical or veterinary use, excluding dental products; biological and chemical preparations for electrophoresis, protease and proteolysis monitoring, proteomics analysis, protein staining, fluorescent protein staining, protein quantification, blot staining, peptide analysis, live cell imaging and buffer preparations and reagents for use in biotechnology and medical research being test kits comprised of alkaline solutions and epicocconone; fluorescent compounds and kits for electrophoresis, protease and proteolysis monitoring, proteomics analysis, protein staining, fluorescent protein staining, protein quantification, blot staining, peptide analysis and live cell imaging, and buffers consisting thereof for medical and veterinary use, including medical and veterinary research

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2523850	Application Date	09/08/1998
Registration Date	01/01/2002	Foreign Priority Date	03/10/1998
Word Mark	LAVA		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 005. First use: [Materials for tooth fillings, dental cements, dental lacquers, impression material for dental uses, duplicating material for dental and dental technical uses, embedding material for dental uses,]material for tooth crowns and tooth bridges for dental and dental technical uses,[bonding material for dental uses,] material for making dental Maryland bridges; [compounding materials for dental duplicating, dental impression, and dental fillings and replacements; dental composite materials, namely, polymerizable plastic materials, with fillers, for use in dental fillings, in dental cements, in dental bonding materials, in] dental veneering materials,[and in dental crowns and bridges]</p> <p>Class 007. First use: Dental and dental technical devices, instruments and apparatus, namely, automated machines for creation of dental replacements; CAD/CAM and computer-manufacturing devices for design and manufacture of dental replacements; and the foregoing with pre-loaded software sold as a unit; dental cutting and milling instruments for the production of dental replacements; scanners for use with the foregoing; parts and mounting hardware for use with the foregoing</p>		

Attachments	2008 09 03 Notice of Opposition 79034429.PDF (11 pages)(104610 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/SWJ/
Name	Scott W. Johnston

Date	09/03/2008
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

3M ESPE AG,)	
)	Opposition No. _____
Opposer,)	
)	Mark: LAVA
v.)	
)	Serial No.: 79/034,429
Fluorotechnics Pty Limited,)	
)	Filing Date: October 20, 2006
Applicant.)	
_____)	Published: May 6, 2008

NOTICE OF OPPOSITION

3M ESPE AG (hereinafter “Opposer”), a corporation organized under the laws of Germany and located at ESPE Platz, Seefeld, D-82229, Germany, believes that it will be damaged by the registration of the mark LAVA shown in trademark application Serial No. 79/034,429, filed October 20, 2006, by Fluorotechnics Pty Limited (“hereinafter “Applicant”), and hereby opposes the same. The grounds for opposition are as follows:

1. By the application herein opposed, Applicant is seeking to obtain under the provisions of the Trademark Act of 1946 as amended, registration on the Principal Register of the trademark LAVA for “biological and chemical products, preparations and reagents other than for medical or veterinary use, being biological and chemical test kits comprised of alkaline solutions and epicocconone for electrophoresis, protease and proteolysis monitoring, proteomics analysis, protein staining, fluorescent protein staining, protein quantification, blot staining, peptide analysis and live cell imaging, and buffers containing products, preparations and reagents for biotechnology and scientific research; fluorescent compounds and kits comprised of alkaline solutions and epicocconone for electrophoresis, protease and proteolysis monitoring, proteomics analysis, protein staining, fluorescent protein staining, protein quantification, blot staining,

peptide analysis, and live cell imaging, and buffers consisting thereof for use in biotechnology and scientific research,” in International Class 1 and “biological products for electrophoresis, protease and proteolysis monitoring, proteomics analysis, protein staining, fluorescent protein staining, protein quantification, blot staining, peptide analysis, live cell imaging and buffer preparations and reagents for medical or veterinary use; chemical products, preparations and reagents for medical or veterinary use, excluding dental products; biological and chemical preparations for electrophoresis, protease and proteolysis monitoring, proteomics analysis, protein staining, fluorescent protein staining, protein quantification, blot staining, peptide analysis, live cell imaging and buffer preparations and reagents for use in biotechnology and medical research being test kits comprised of alkaline solutions and epicocconone; fluorescent compounds and kits for electrophoresis, protease and proteolysis monitoring, proteomics analysis, protein staining, fluorescent protein staining, protein quantification, blot staining, peptide analysis and live cell imaging, and buffers consisting thereof for medical and veterinary use, including medical and veterinary research,” in International Class 5.

2. Applicant’s mark published for opposition on May 6, 2008. Opposer filed and the Board approved an extension of time to oppose Applicant’s mark until September 3, 2008. This Notice of Opposition is timely filed.

3. Since long before Applicant’s filing date, Opposer has been using the trademark LAVA to identify and promote its unique dental and dental technical devices, instruments and apparatus for use in making crowns, bridges, dental replacements and orthodontics appliances, and related products and services.

4. Opposer owns Registration No. 2,523,850, issued January 1, 2002, for the mark LAVA for “material for tooth crowns and tooth bridges for dental and dental technical uses,

material for making dental Maryland bridges; dental veneering materials,” in International Class 5 and “dental and dental technical devices, instruments and apparatus, namely, automated machines for creation of dental replacements; CAD/CAM and computer-manufacturing devices for design and manufacture of dental replacements; and the foregoing with pre-loaded software sold as a unit; dental cutting and milling instruments for the production of dental replacements; scanners for use with the foregoing; parts and mounting hardware for use with the foregoing,” in International Class 7. The registration issued from an application filed September 8, 1998, with priority to a German registration filed March 10, 1998, under Section 44(e) of the Lanham Act, 15 U.S.C. § 1126(e). A current printout of information from the electronic database records of the USPTO showing the current status and title of the registration is attached hereto as Exhibit A.

5. Registration No. 2,523,850 is incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065. Consequently, this registration is conclusive evidence of the validity of the registered mark and of the registration of the mark, of Opposer's ownership of the mark, and of Opposer's exclusive right to use the registered mark in commerce under Section 33 of the Lanham Act, 15 U.S.C. § 1115.

6. Opposer also owns pending U.S. trademark application Serial No. 77/357,944, filed December 21, 2007, for the mark LAVA for “oral scanners, and related software for use with such scanners, for use in dentistry and orthodontics to obtain and transmit images; dental and orthodontic equipment, namely, laboratory scanners, milling units, and furnaces, and related software and parts for use with such equipment, for use in making crowns, bridges and orthodontic appliances,” in International Class 10.

7. Opposer has advertised and promoted its LAVA mark continuously and extensively, and made substantial sales of products under said mark. As a result of such

continuous use and promotion, the LAVA mark has developed and represents valuable goodwill inuring to the benefit of Opposer.

8. There is no issue of priority concerning application Serial No. 79/034,429 since Opposer has used and registered its LAVA mark prior to Applicant's October 20, 2006, filing date. For example, Opposer's Registration No. 2,523,850 registered January 1, 2002, nearly four years before Applicant's filing date for its application. In addition, Opposer's registration gets the benefit of the March 10, 1998, priority date, which is more than eight years before Applicant's filing date. Opposer therefore has priority over Applicant with respect to the marks at issue.

9. Upon information and belief, Applicant had not used Applicant's mark in commerce prior to Applicant's October 20, 2006, filing date. In addition, upon information and belief, Applicant has not used Applicant's mark in commerce.

10. Upon information and belief, Applicant had knowledge of the fact that Opposer used the term LAVA as a trademark before it adopted the LAVA mark.

11. Applicant's LAVA mark is identical in sight, sound and commercial impression to Opposer's LAVA mark.

12. Applicant's alleged goods are closely related to Opposer's goods marketed and sold by Opposer in connection with its LAVA mark, and for which Opposer owns a registration. For example, both parties' goods can be used in the dental and orthodontic fields.

13. Upon information and belief, Opposer's and Applicant's products are sold in the same channels of trade to the same consumers or class of consumers.

14. Due to the identical nature of Applicant's claimed mark, LAVA, and Opposer's previously used and registered LAVA mark, the closely related nature of the goods of the

respective parties, customers and potential customers are likely to believe that Applicant's product originates from Opposer, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.

15. The use and registration by Applicant of the mark LAVA for Applicant's goods is likely to cause confusion or to cause mistake or deception in the trade, and among purchasers and potential purchasers, with Opposer's previously used LAVA mark, again resulting in damage to Opposer.

16. Because of the closely related nature of the goods, and that the marks are identical, use and registration of the term LAVA by Applicant is likely to cause confusion, mistake, or deception that Applicant's goods are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer for use with Opposer's products causing further damage to Opposer.

17. Registration of the mark shown in application Serial No. 79/034,429 will result in damage to Opposer under the provisions of Section 2 of the U.S. Trademark Act, 15 U.S.C. Section 1052, pursuant to the allegations stated above.

WHEREFORE, Opposer asks that its opposition to this application be sustained and that registration of the term LAVA for the goods and services set forth therein be refused.

Please direct all correspondence to:

Scott W. Johnston
MERCHANT & GOULD P.C.
P.O. Box 2910
Minneapolis, MN 55402-0910

Opposer herein appoints John A. Clifford, Reg. No. 30,247; Gregory C. Golla; Andrew S. Ehard; Scott W. Johnston, Reg. No. 39,721; Heather J. Kliebenstein; Danielle I. Mattessich; Scott M. Oslick; Christopher J. Schulte; William D. Schultz, and all other attorneys of the firm of Merchant & Gould P.C., its attorneys to transact all business in the U.S. Patent and Trademark Office relating to this matter with full power of substitution.

Respectfully submitted,

3M ESPE AG

By its Attorneys,

Date: 9-3-08

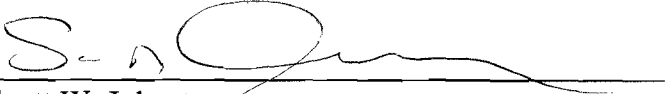
A handwritten signature in black ink, appearing to read "Scott W. Johnston", written over a horizontal line.

Scott W. Johnston
MERCHANT & GOULD P.C.
80 South Eighth Street, Suite 3200
Minneapolis, Minnesota 55402-2215
(612) 332-5300

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION
was served upon the following Domestic Representative of record for Applicant by First Class
Mail, postage pre-paid, this 3rd day of September, 2008:

Janice W. Housey
Latimer, Mayberry & Matthews IP Law, LLP
13873 Park Center Road, Suite 106
Herndon, VA 20171



Scott W. Johnston

EXHIBIT A

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-09-03 15:19:34 ET

Serial Number: 75549685 Assignment Information Trademark Document Retrieval

Registration Number: 2523850

Mark (words only): LAVA

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2008-02-24

Filing Date: 1998-09-08

Transformed into a National Application: No

Registration Date: 2002-01-01

Register: Principal

Law Office Assigned: LAW OFFICE 115

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2008-02-24

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. 3M ESPE AG

Address:

3M ESPE AG

ESPE PLATZ

SEEFELD 82229

Fed Rep Germany

Legal Entity Type: Corporation

State or Country of Incorporation: Fed Rep Germany

GOODS AND/OR SERVICES

International Class: 005

Class Status: Active

material for tooth crowns and tooth bridges for dental and dental technical uses, material for making dental Maryland bridges; dental veneering materials

Basis: 44(e)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 007

Class Status: Active

Dental and dental technical devices, instruments and apparatus, namely, automated machines for creation of dental replacements; CAD/CAM and computer-manufacturing devices for design and manufacture of dental replacements; and the foregoing with pre-loaded software sold as a unit; dental cutting and milling instruments for the production of dental replacements; scanners for use with the foregoing; parts and mounting hardware for use with the foregoing

Basis: 44(e)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Foreign Application Number: 39813372.7

Foreign Registration Number: A9569634

Foreign Registration Date: 1998-05-12

Country: Fed Rep Germany

Foreign Filing Date: 1998-03-10

Foreign Expiration Date: 2008-03-31

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-02-24 - Section 8 (6-year) accepted & Section 15 acknowledged

2007-12-20 - Assigned To Paralegal

2007-12-18 - TEAS Section 8 & 15 Received

2007-04-18 - Case File In TIGRS

2002-01-01 - Registered - Principal Register

2001-10-26 - ITU claim deleted

2001-02-28 - Notice of Allowance canceled

2001-09-22 - Reinstated

2001-07-28 - Abandonment - No use statement filed
2000-08-29 - Notice of allowance - mailed
2000-06-06 - Published for opposition
2000-05-05 - Notice of publication
2000-01-06 - Approved for Pub - Principal Register (Initial exam)
1999-12-22 - Examiner's amendment mailed
1999-10-26 - Communication received from applicant
1999-04-30 - Non-final action mailed
1999-04-30 - Assigned To Examiner
1999-04-15 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

James F. Voegeli

Correspondent

James F. Voegeli
3M Innovative Properties Company
220-9E-01
3M Center, 2501 Hudson Road
St. Paul MN 55144
Phone Number: 651 736-6989
Fax Number: 651 736-3783

Domestic Representative

Ladas & Parry